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Docket NCR11393

EXPEDITED PROCEDURE  
RESPONSE UNDER 37 CFR 1.116  
Group Art Unit 1772

REMARKS

Reconsideration of the above identified application is respectfully requested.

On 01/26/2006, the undersigned attorney conducted a phone interview with examiner Watkins to briefly discuss the rejections of record for claims 3, 20, and 21, in particular.

The amended features of claims 3 & 20 were discussed for the form of the slit diecut; and the identical configuration of the sheets recited in claim 21 was discussed in evaluating the differences over the applied art.

Although no agreement was reached, this amendment is being presented consistent with the interview for further consideration by the examiner.

Applicant traverses the repeated rejection of claims 1 & 2 under Section 102(b) over Spencer.

The examiner has repeated his previous contentions, and Applicant incorporates herein by reference the previous traverse thereof.

Applicant also traverses the repeated rejection of claims 1-9, 11, 12, and 20 under Section 102(b) over May; and the additional rejection of newly added claims 20-23 & 25.

Since the examiner has repeated his previous contentions; Applicant incorporates herein by reference the previous traverse thereof.

In para. 9 of the office action, the examiner presents additional contentions, which Applicant traverses for lack of evidentiary and legal support.

The examiner has admittedly failed to afford any weight to the recited "diecuts," which appears erroneous under the applicable MPEP provisions.

The examiner even argues that "laser cutting or even sawing can produce similar shaped holes," when no "holes" either "similar" or not, are recited in the claims. The

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claims expressly recite "diecuts," and the examiner has failed to afford any weight thereto.

Is a "rose" the same as a "tulip," under the examiner's expansive interpretation of applicable MPEP and statutory provisions? They are both flowers.

The examiner argues "no evidence," yet, the examiner has failed to extend his search to relevant search classes as implored by the Applicant.

If the examiner continues to avoid expansion of the search as an undue "burden," then the examiner may simply take Judicial Notice of the notoriously well known use of die cuts in the stationery art.

For example only, a cursory search of the art made following the interview has uncovered USP 6,432,499 and 6,746,742; assigned to the present assignee, which disclose various adhesive labels and the die cuts found in the sheet constructions thereof.

These patents are now referenced solely for the Judicial Notice evidence of the well known die cuts presented therein, which would therefore be well known to those skilled in the art.

As indicated above, both references being applied by the examiner lack any teaching of relevant diecuts, and, indeed, do not even use that term when describing and claiming the various features thereof.

It is only the examiner, in hindsight use of those references, who must distort the very terms thereof in the attempt to uncover corresponding features to support the rejections.

At page 6 of the office action, the examiner opines that the illustrated layers in Spencer "appear" to be otherwise identical, with same slit pattern; but the examiner has failed to identify where this is shown.

In figure 1 of Spencer, for example, all three layers

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"appear" to be different. Note the 3-lines in the left corner slot do not match the 2-lines in the right corner slot. Or, the 6-lines in the next left slot do not match the 5-lines in the next right slot. And the slots 14 in the second layer have different orientations than the 1st & 3rd layers. These are examples.

The examiner's new contention that "elements 25, 26, 25a, 26a, and 30 ... could be formed by cutting of the sheets with dies" is not supported by any evidence, and is per se erroneous under the stringent requirements of Section 102.

With respect to added claims 21-23 & 25, the examiner has failed to afford any weight to the combination of features therein.

These claims recite "identical configurations" of the sheets "except for offset of the diecuts."

There can be no doubt that May clearly does not disclose "identical" dividers 10. Figures 3 and 8 clearly illustrate different patterns of the indentations, which the examiner has not listed under his definition of "diecuts."

Instead, the examiner simply contends in para. 9 that the "sheets in May are taught as being substantially identical ... except for ... protrusions ...." But, the examiner has not previously used those "protrusions" as "diecuts," and ipso facto the sheets in May cannot have identical configurations as claimed.

Applicant traverses the repeated rejection of claims 9-12 under Section 103(a) over Applicant's paras. 5 & 9 and May; and the additional rejection of claims 3-8 and 20-25 co-listed therewith.

The examiner has repeated his contentions; and Applicant incorporates herein by reference the previous traverse thereof.

The examiner's re-characterization, in para. 9, of the field of endeavor and problems in May, was predicted, and is

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not permitted by the MPEP and case law.

The examiner's conclusion of obviousness as presented in para. 9 fails to comply with the MPEP requirements, and lacks legal motivation.

Simply adding "notches in the admitted key holders ..." as the examiner contends has no relevance with any of the rejected claims.

Adding the "notches" from May would render inoperable for its intended purpose the "key holder" since the notches in May are disposed along the perimeter of the divider, and therefore have no "key holding" capability. And the apertures 30 disclosed in May also lack any key holding capability, and the examiner has not shown otherwise in his conclusions presented in para. 9.

At page 7 of the office action, the examiner implicitly recognizes his "over broadly constructed" view of the references; compounded now by the repeated failure to afford due weight to the recited "diecuts" and cooperation of elements therewith.

During the phone interview, the examiner courteously reconsidered the previous amendments to claims 3 and 20, and requested additional comments from the Applicant in this regard.

Claims 3 & 20 expressly recite the slit form of the diecuts, and it is quite clear that no such form of diecut is disclosed, or suggested by May.

The examiner's list of elements 25, 26, 25a, 26a, and 30 in May does not include slit diecuts; and there are no such diecuts in May since the dividers disclosed therein are fundamentally different, and non-analogous art as previously explained.

Elements 25, 26, 25a, and 26a, listed by the examiner, in May are clearly side notches formed around the perimeter of the divider for a special purpose having no counterpart in

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the simple "key holder" being applied by the examiner.

Element 30, also listed by the examiner, in May is a round aperture, yet again, provided for a special purpose not relevant to the "key holder" being applied by the examiner.

And, the various indentations 27,28,29, "protrusions" as listed by the examiner, are conspicuous over the entire area of the dividers in May, and have no relevance to the recited claims, or diecuts in particular.

The examiner characterizes May for "The problem of sheets sticking together would be involved during automated production using sheets of the admitted prior art key holders disclosed by applicant." What does this mean?

The key holders are specially configured for feeding in the ubiquitous printer.

The dividers in May are differently configured for special handling, not in the ubiquitous printer, but in the differently configured beverage container packaging machine illustrated in Figure 1.

The differences in application and configuration and structure could not be any greater.

Applicant has presented de novo the special problem of interlocking diecuts having no counterpart in May.

Suppose the dividers in May stuck together because of stray adhesive therebetween? What would be the solution for that problem? Clearly not the solution taught by May.

What is the relevance of that problem? The MPEP is quite clear that references can only be combined based on legal motivation, not hindsight conclusions, and based on evidence and the evaluation of the whole, including the specific problems being solved.

The examiner has not found in May the specific interlocking problem, since the dividers are configured differently and do not have that problem.

The dividers in May have a different problem, or

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problems.

Yet, the problems actually disclosed by May and solved by May have no nexus, either logical or legal, with Applicant's interlocking problem. Any solution taught by May would therefore have no relevance to any modification of the "key holder" as the examiner opines in hindsight.

It is clear, that neither reference discloses nor suggests diecuts, or the combination thereof as presented in the various claims. Especially for the slit diecuts, which the examiner is hereby requested to reconsider.

In view of the cooperation shown by the examiner during the interview, and as discussed with the examiner, claim 1 is being amended to insert therein the previously added "stationery" and "inboard slit diecut" elements found in claim 3, from which they are being deleted as redundant.

Independent claim 20, as previously amended, also includes these features.

And, independent claim 21, with its novel identical features, has also been amended to add the "stationery" and "slit diecut" features to additionally distinguish over May.

These amendments and remarks should remove the entire rejection under Section 102 based on Spencer.

And, this should also remove the entire rejections under both Sections 102 and 103 based on May, since May clearly does not disclose or suggest slit diecuts in the recited cooperation as explained above.

And, the examiner's use of the key holder disclosed by Applicant in the specification merely recognizes the problem uncovered by the present Applicant in one exemplary stacked sheet. The examiner has not identified any teaching to solve that interlocking problem.

And, the different problems and different solutions of May lack any nexus for modifying the exemplary key holder in any manner. The simple modification of that key holder to

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introduce therein the "elements 25, 26, 25a, 26a, and 30" of May as listed by the examiner would have no utility at all, and would not solve the problem of interlocking of the otherwise aligned diecuts found therein in a special pattern.

The pattern of elements 25,26,25a,26a,30 of May have no capability for holding any key, and would simply render inoperative the recited sheets for their intended purpose of holding keys.

Lastly, Applicant notes the examiner's suggestion for Applicant to conduct an independent search.

However, applicants file patent applications for the express purpose of having experienced examiners in the USPTO conduct thorough searches of the myriad of patents in accordance with applicable standards for determining the due scope of claims to which the present Applicant is entitled under the US Constitution.

Rule 104 is clear, and is reproduced in part:

Patent Rule 104 - Nature of Examination

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters ....

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

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(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

As previously indicated, it is not seen how the MPEP supersedes the Patent Rules and permits the examiner to limit searching irrespective of any "burden" associated with any searching in the USPTO.

The two patents identified above for the conventionality of die cuts may be used by the examiner for ensuring that all relevant art classes have been searched under Rule 104.

And, the stationery product application previously mentioned in the last response is Appln. No. 10/290,944; presently pending, which recites an internet stamp formed in sheets and defined by ubiquitous diecuts, and the examiner may use his judgment to determine if that application provides any relevant search fields for the present application, or any support for extending the search to additionally relevant search classes.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is again requested to reconsider not only the art of record, but also update the prior art search to uncover additional references specifically related to stationery products and diecuts therein, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on



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the importance of this examiner duty in Ex parte Schriker, 56 USPQ2d 1723 (B.P.A.I. 2000).

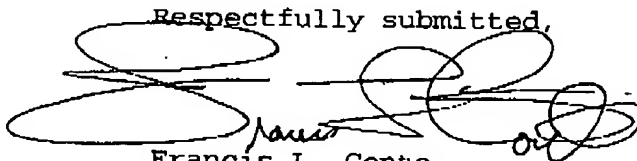
In view of the above remarks, allowance of claims 1-12 and 20-25, over the art of record is warranted and is requested.

And, withdrawal of the restriction requirement is further warranted and requested; and method claims 13-19 should now be rejoined, and the prior art search again updated specifically therefor, along with due examination of these method claims as well. See MPEP 821.04.

Those method claims 13-19 are well distinguishable over the references Spencer and May of record, which clearly provide no teaching of any related method of making or method of using.

Allowance of method claims 13-19 is also warranted and is requested.

Respectfully submitted,



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